

A circular black ink stamp from the Patent & Trademark Office. The text "PATENT & TRADEMARK OFFICE" is curved along the bottom inner edge. The date "MAR 05 2008" is stamped in the center. Along the top inner edge, the words "OFFICE" and "IAP87" are visible, separated by a horizontal line.

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0-4373) ~~8~~

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)\ Patentees	ROBERTS et al.	Confirmation No.:	4605
Serial No.:	10/632,817	Filed:	August 4, 2003
US Patent No.:	7,258,813 B2	Issued:	August 21, 2007
		Examiner:	J. Hardee
		Art Unit:	1751

For: REFRIGERANT COMPOSITION

**PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b)
AND
PETITION FOR EXPEDITED HANDLING**

Mail Stop – Petitions
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-4150

Sir:

Applicants/Patentees request, pursuant to 37 C.F.R. § 1.137(b), that the above-identified application, U.S. Application Serial No. 10/632,817, to the extent that it became abandoned in 2006 be revived and have the entirety of its examination and prosecution history from October 25, 2005, (the mailing date of the first non-final Office Action on the merits) through to August

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01 FC:1453	1540.00 DA
02 FC:1462	400.00 DA

21, 2007 (the date the application was published/issued as U.S. Patent No. 7,258,813 B2) be made whole.

Applicants also request that these Petitions to Revive be accorded expedited handling, pursuant to 37 C.F.R. § 1.182.

The Commissioner for Patents is hereby authorized to charge the requisite (1) \$1540.00 fee for the filing of the alternative Petition to Revive under 37 C.F.R. § 1.137(b), and (2) \$400.00 fee for the filing of the Petition for Expedited Handling of these petitions to Deposit Account No. 13-4500, Order 2119-4373. The Commissioner for Patents is authorized to charge any additional fees that may be required for the filing, consideration, and granting of these petitions, or credit any over payment, to Deposit Account No. 13-4500, Order 2119-4373.

BACKGROUND

On August 4, 2003, the above-identified application was filed with the United States Patent and Trademark Office (USPTO) and accorded U.S. Application Serial No. 10/632,817 (hereinafter “the ‘817 Application”), as a continuation-in-part of a co-pending application and claiming priority to patent applications previously filed in the United Kingdom. The ‘817 Application was then owned by Rhodia Organique Fine Limited, a non-United States based company. The USPTO mailed a Notice to File Missing Parts of Nonprovisional Application on October 31, 2003. Applicants timely filed an acceptable Combined Declaration and Power of Attorney, surcharge, and petition and fee for a one (1) month extension of time responsive to the Notice to File Missing Parts.

On June 10, 2005, the USPTO mailed an Election/Restriction requirement.

In August 2005, the '817 Application along with other assets, including other United States and non-U.S. patents and patent applications, were sold by Rhodia Organique Fine Limited to E. I. du Pont de Nemours and Company, a Delaware corporation.

Responding to the outstanding Election/Restriction requirement, a response and a petition and fee for a three (3) month extension of time was timely filed by Applicants/Patentees on October 6, 2005.

On October 24, 2005, the USPTO mailed a first non-final Office Action on the merits, which set forth an extendable three (3) month statutory period for response. With respect to the prior art based rejections, the Examiner entered an obviousness rejection under 35 U.S.C. § 103(a). It is this October 24, 2005, mailing date of the first non-final Office Action that is the beginning date for which the wholeness of the prosecution is now sought.

Applicants/Patentees timely filed a response to this first non-final Office Action in the form of a Request for Continued Examination (RCE), which was accompanied by a petition and fee for a three month extension of time, and additional references for consideration by the Examiner (via a supplemental Information Disclosure Statement (IDS)) on April 24, 2006.

On May 15, 2006, the USPTO mailed a second non-final Office Action on the merits setting forth an extendable three (3) month shortened statutory period for response. In the May 15, 2006 non-final Office Action, the Examiner entered a new ground of rejection under 35 U.S.C. § 102(b) in view of the newly submitted non-patent literature reference entitled "*1998 International Refrigeration Conference at Purdue*," submitted with the April 24, 2006,

Information Disclosure Statement. *See* Page 3, Items 7 and 8, of the May 15, 2006, second non-final Office Action.

In addition to the new rejection based on an anticipatory reference, the May 15, 2006 Office Action maintained the content of the October 24, 2005 non-final Office Action and entered Applicants' Request for Continued Examination, dated April 24, 2006.

Responsive to the second non-final Office Action, Applicants/Patentees timely filed a response, entitled "Amendment and Remarks," on August 14, 2006, which was closely followed by the filing of additional supplemental Information Disclosure Statements. A telephonic interview and a face-to-face interview with the Examiner were conducted by Applicants'/Patentees' counsel on August 22 and 25, 2006, respectively.

On September 12, 2006, the USPTO mailed a final Office Action on the merits setting forth an extendable three (3) month shortened statutory period for response therein.

Applicants/Patentees timely filed a Notice of Appeal to the Board of Patent Appeals and Interferences and a petition and fee for a three (3) month extension of time on March 12, 2007. Subsequently, on March 21, 2007 Applicants/Patentees filed a second RCE, a Response and Amendment to the then-outstanding final Office Action, and another supplemental Information Disclosure Statement. A face-to-face interview with the Examiner was also conducted by Applicants'/Patentees' counsel on March 21, 2007.

On May 4, 2007, the USPTO mailed a Notice of Allowance and Fee(s) Due, which set forth a three month statutory period for payment of the Issue Fee. On May 18, 2007, Applicants/Patentees timely filed an Amendment to Specification and Comments relating to the

Examiner's Statement for Notice of Allowance. The requisite Issue Fee was timely paid on June 21, 2007. A Supplemental Notice of Allowability, in response to the May 18, 2007, Amendment to the Specification, was mailed by the USPTO on July 12, 2007. An Issue Notification was mailed by the USPTO on August 1, 2007.

On August 21, 2007, the '817 Application was published as U.S. Patent No. 7,258,813 B2 (hereinafter "the '813 Patent"). August 21, 2007, the publication/issue date of the '813 Patent, that is the ending date for which wholeness of the prosecution is now sought. Although Applicants/Patentees are requesting that the entire prosecution history be made whole from October 24, 2005 through to August 21, 2007, the time period for which revival is being sought is April 24, 2006 to the filing of a grantable petition to revive.

DISCUSSION

The Applicants/Patentees recently discovered that the '817 Application may be interpreted as having become abandoned on or around April 24, 2006, the date that the extended shortened statutory time period for response to the October 24, 2005, first non-final Office Action expired. This possible abandonment may have occurred because Applicants'/Patentees' April 24, 2006, response to the first non-final Office Action may be interpreted as an insufficient response. The preparation and filing of the April 24, 2006 RCE and accompanied papers occurred in the midst of a series of internal Attorney docket reassignments, which included the '817 Application, and was inadvertently filed.

The entirety of Applicants' April 24, 2006, response (i.e., RCE, extension of time, and IDS), was entered by the USPTO. In addition, the USPTO continued to examine the '817 Application on its merits. Consequently, Applicants continued the prosecution process until the USPTO published/issued the '817 Application as the '813 Patent on August 21, 2007. At no time, did Applicants/Patentees intend to not prosecute the '817 Application. Only recently and well after the publication/issuance of the '813 Patent did Applicants/Patentees discover that the '817 Application may be interpreted as having become abandoned in 2006.

Compounding the circumstances of Applicants/Patentees April 24, 2006 filing, was the fact that the USPTO never notified the Applicants/Patentees that it believed that the April 24, 2006 response was insufficient. Rather, the USPTO forwarded the April 24, 2006 response to the Examiner to permit the invention of the '817 Application to be further examination on its merits. Indeed, the Examiner reviewed Applicants' newly provided references, examined the then-pending claims, and entered a new rejection, based on anticipation, and re-entered the previously entered obviousness rejection, against the then-pending claims. *See* the Office Action dated May 15, 2006, as discussed above.

Because Applicants/Patentees were unaware that the RCE filed April 24, 2006 was insufficient and that prosecution on the '817 Application continued as if such RCE was sufficient, Applicants/Patentees did not come to appreciate the potential interpretation of the April 24, 2006 RCE until recently. The delay in filing a full response to the October 24, 2005 non-final Office Action up to and including the date of filing of this grantable Petition was unintentional. Applicants/Patentees believe that such delay was also unavoidable.

To the extent necessary to avoid the interpretation that the '817 Application was abandoned on April 24, 2006, Applicants/Patentees request that the '813 Application be revived and that the entirety of its examination and prosecution be made whole under the provisions of 37 C.F.R. § 1.137(b).¹ The requirements for this petition to revive and make whole are met by: (1) the entirety of the prosecution filed between April 24, 2006 to August 17, 2007, all of which was previously filed, and constitutes the required reply to the then outstanding Office Action; (2) payment of the petition fee set forth in 37 C.F.R. § 1.17(m) per the accompanied deposit account authorizations; and, (3) Applicants'/Patentees' statements herein and the above statement that the entire delay in filing the required reply to the outstanding Office Action, when measured from the due date for the reply until the filing of this grantable petition, was unintentional. Applicants/Patentees submit that no terminal disclaimer is believed to be required since the '817 application was filed after June 8, 1995 (37 C.F.R. § 1.137(c)).

In view of the above, Applicants/Patentees respectfully submit that all of the requirements for revival of the '817 Application, pursuant to provisions of 37 C.F.R. § 1.137(b), and make its examination and prosecution history whole have been satisfied. Is it respectfully requested that this petition be granted.

¹ A petition to revive an abandoned application on the basis of unintentional delay, must be accompanied by: (1) the required reply to the outstanding office action, unless previously filed, (2) the petition fee as set forth in 37 CFR § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) any required terminal disclaimer.

CONCLUSION

Applicants/Patentees respectfully request that (1) the '817 Application, to the extent that it is interpreted as having become abandoned, be revived under 37 C.F.R. § 1.137(b), thereby making whole the entirety of its examination and prosecution history beginning from the October 25, 2005, (the mailing date of the first non-final Office Action on the merits) through to August 21, 2007 (the date the application was published/issued as U.S. Patent No. 7,258,813 B2), and (2) the Petition to Revive under 37 C.F.R. § 1.137(b) be accorded expedited handling pursuant to 37 C.F.R. § 1.182.

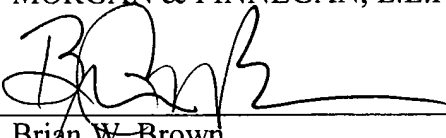
AUTHORIZATION

The Commissioner is hereby authorized to charge all petition fees and any additional fees that may be required for the filing, consideration, and granting of these petitions to Deposit Account No. 13-4500, Order No. 2119-4373.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: March 5, 2008

By: _____


Brian W. Brown
Registration No. 47,265

Address

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(202) 857-7887 Telephone
(202) 857-7929 Facsimile



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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2008		Complete if Known	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Application Number	10/632,817
TOTAL AMOUNT OF PAYMENT (\$)		Filing Date	August 4, 2003
		First Named Inventor	Roberts, et al.
		Examiner Name	J. Hardee
		Art Unit	1751
		Attorney Docket No.	013235-016 (2119-4373)

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 13-4500 Deposit Account Name: Morgan & Finnegan LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	210	105
Multiple dependent claims	370	185

Total Claims Extra Claims Fee (\$) Fee Paid (\$)

_____ - 20 or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)

_____ - 3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____ / 50 = _____ (round up to a whole number) x _____ = _____		

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	
Other (e.g., late filing surcharge): <u>Petition to Revive; Petition to Expedite</u>	<u>1,940.00</u>

SUBMITTED BY		
Signature		Registration No. (Attorney/Agent) <u>47,265</u>
Name (Print/Type)	<u>Brian W. BROWN</u>	Telephone <u>202-857-8027</u>
		Date <u>March 5, 2008</u>

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.